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In re application of
Randell L. Mills.
Serial No. 09/362,693
Filed: July 29, 1999
For: INORGANIC-HYDROGEN AND HYDROGEN-POLYMER COMPOUNDS AND APPLICATIONS THEREOF

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 9, 2001.

On September 11, 2000, a non-final office action was mailed to applicant (paper no. 3). The office action contained a rejection of all the claims under 35 USC 101 as lacking utility and 35 USC 112, first paragraph as lacking enablement. In addition, there were two provisional rejections under 35 USC 101 (double patenting) over some of the claims and two provisional rejections of all remaining claims under provisional obviousness type double patenting. Also, some of the claims were rejected over 35 USC 112, second paragraph for being indefinite. Lastly, several of the claims were rejected as being unpatentable under 35 USC 102/103.

A reply to the office action was filed by Applicant on March 12, 2001. Applicant cancelled claims 1-101 thereby obviating all of the double patenting rejections, the 35 USC 112, second paragraph rejections and the 35 USC 102/103 rejection. Applicant also presented arguments in an attempt to overcome the aforementioned 35 USC 101(utility) and the 35 USC 112, first paragraph rejection. Additionally, declarations under Rule 132 were filed on June 8, 2001 and June 22, 2001.

On July 9, 2001 a final office action was mailed (paper no. 10). All of the provisional double patenting rejection were withdrawn. The 35 USC 112, second paragraph rejections and the 35 USC 102/103 rejections were also withdrawn. The rejections under 35 USC 101(utility) and 35 USC 112, first paragraph were also maintained.

Petitioner has argued that the finality of the last office action is improper. Petitioner argues that the finality is premature due to the introduction of new grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. Additionally, it is argued that a clear issue between applicant and examiner has not been developed.

DECISION

The non-final office action mailed September 11, 2000 contained rejections over claims 1-121 under 35 USC 101 (utility) and 35 USC 112, first paragraph. The office action presented arguments as to why the claims lack utility and enablement under the appropriate statute. Applicant's response to this office action, filed March 12, 2001 attempted to rebut the positions set forth in the September 11,

2000 office action. Applicant canceled claims 1-101 and added new dependent claims 121-204. In the final office action mailed July 9, 2001, the examiner maintained the previous grounds of rejection of claims 102-120 under 35 USC 101 (utility) and 35 USC 112, first paragraph. The examiner specifically refers back to the non-final office action for the reasoning behind the rejections (see the final office action, page 2, lines 9 and 14-15). The examiner also added newly presented dependent claims 121-204 to the rejections under 35 USC 101 and 35 USC 112, first paragraph. In addition, the examiner responded to Applicant's arguments in a separate section (see final office action - Attachment). In the attachment, the examiner addressed the arguments set forth by Applicant in the response filed March 12, 2001 and the Rule 132 declarations. As to the first issue of premature finality, the MPEP states the following:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)

In the instant case, no new ground of rejection was applied to the claims rejected in the first office action. The 35 USC 101 and 112, first paragraph rejections were the same as those in the previous non-final action (in fact the examiner refers back to the previous office action for the reasoning in making the rejections). The newly presented rejection of the newly added dependent claims was clearly necessitated by Applicant's amendment because these claims were not previously presented for examination. The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by Applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of novelty and enablement as set forth in the previous office action).

As to the second issue of premature finality, the MPEP states the following:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

In the present case, a clear issue has in fact been developed between the examiner and applicant. In the non-final action mailed September 11, 2000, the primary grounds of rejection were the 35 USC 101 (utility) and 35 USC 112, first paragraph rejections mentioned above. The examiner set forth reasoning to support these rejections. Applicant then replied to the rejections and the positions of the examiner. The rejections were maintained in the final office action and the examiner answered the arguments filed by Applicant relating to the issue of whether the claims were lacking in utility and enablement. The issues in the present application are clear - whether the claims lack utility and are enabled to one of ordinary skill in the art.

Accordingly, the examiner properly made the July 9, 2001 office action final.

The Petition is **DENIED**.

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